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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,662	08/19/2003	Jesus Bengoa	BOE01 021	3469

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EXAMINER

PICKARD, ALISON K

ART UNIT	PAPER NUMBER
3673	

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/642,662

Applicant(s)

BENGOA ET AL.

Examiner

Alison K. Pickard

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

**\*\* Please remove references to the claims in the specification.**

#### ***Election/Restrictions***

1. Applicant's election with traverse of Group 1 in the reply filed on 7-31-06 is acknowledged. The traversal is on the ground(s) that (1) the action fails to provide reasons and (2) there is not a serious burden for the examiner. This is not found persuasive because the examiner contends that the different species disclosed and claimed are independent and distinct embodiments/inventions. Each of the species (embodiments) are mutually exclusive one from another and would form separate inventions as with one not being used or made with another and (2) The examiner argues that to competently and completely search four different embodiments of the seals, each comprised of distinct/unique features, would be a serious search burden. Furthermore, since claim 1 is rejectable over art, the depending claims need to be addressed/searched for their individual limitations. If the multiple embodiments were not restricted, a serious search burden would be present.

The requirement is still deemed proper and is therefore made FINAL.

**\*\* Note:** the examiner has modified the election to four groups relating to figures 1, 2, 6, and 7, respectively (i.e. figure 5 has been withdrawn as a separate embodiment).

2. Claims 13-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in the reply filed on 7-31-06.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10, “the further contact surface” and “the radial leg” lack antecedent basis.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4, 5, 7, 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kanda (5,469,710).

Kanda discloses a seal comprising a first casing 14 and second casing 12. The first has a radial lip 74, axial lip (e.g. 82), protective lip (e.g. 76), rubber seat 44, and a stop (either part of 64 or 16). The second has a contact surface 30 and is keyed to a shaft/axle 18.

7. Claims 1-9, 11, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Messenger (5,004,248).

Messenger discloses a seal comprising a first casing 38 and second casing 32. The first has a radial lip 46, stop 72, an axial lip (e.g. 64, that is considered corrugated by the plural ridges), a protective lip (e.g. 64 or 48), and a rubber seat 82. The second has a contact surface 50 and extension (Figure 8) and is keyed to the shaft/axle/ring 8 (in as much as Applicant's is shown keyed to these elements).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 4, 5, 7, 9-12, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (page 1) in view of Kanda.

Applicants disclose that it is known to mount a cartridge seal on a shaft/axle by a flange/connecting member to clamp it in place. However, Applicants do not disclose the features of the seal. Kanda teaches an improved unitized cartridge seal with dirt exclusion. Kanda teaches the seal is for a wheel bearing. Kanda teaches the use of a tool to install the seal in place. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use the cartridge seal taught by Kanda as the seal mounted and clamped on the wheel bearing to provide a seal with improved dirt exclusion capability.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 571-272-7062. The examiner can normally be reached on M-F (10-7:30), with alternate Friday's off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tricia Engle can be reached on 571-272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Alison K. Pickard  
Primary Examiner  
Art Unit 3673

AP